

Remarks/Arguments

Claims 2 to 6, 12 to 14 and 21 are pending. Claim 1 has been cancelled. Claims 7 to 11 and 15 to 20 were previously canceled. Claims 2 to 6 have been amended.

The Office Action stated that applicants' election of Group 1, Claims 1 to 6 and 12 to 14, in the reply filed on 01/24/2006 is acknowledged. Applicants confirm this election but refer to the discussion below.

The Office Action stated that, because applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse [MPEP § 818.03(a)].

The Office Action stated that the information disclosure statement filed on 12/05/2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document, each non-patent literature publication or that portion which caused it to be listed, and all other information or that portion which caused it to be listed. Applicants traverse this statement because applicants believe that a copy of the U.S. and foreign patent documents cited in such art statement (I.D.S.) and such reference list (Form PTO-1449).

Enclosed is a copy of the postcard receipt that was subsequently returned (mailed) by the Patent Office after the Patent Office placed the serial number sticker. Note that the sticker contains the serial number, the filing date, and baser code, and the designation "00727 U.S.P.T.O". Further note that such postcard receipt lists "a Information Disclosure Statement with reference list and copies of the cited references" as being enclosed and a request that the Patent

Office acknowledge receipt thereof by placing a receiving stamp thereon, and mailing back such postcard receipt.

Also enclosed is a copy of the postcard receipt that the Patent Office stamped as received when this application and accompanying documents were filed by hand-carrying to the Patent Office.

Accordingly, applicants request that the Examiner consider the cited foreign references and indicate so on the PTO Form 1449. To assist the Examiner the applicants have enclosed a copy of the PTO Form 1449.

The Office Action stated that it has been placed in the application file, but the information referred to therein has not been considered. The above and enclosed information shows that the Examiner should reverse his position and fully consider the information in the foreign references.

The Office Action stated that the following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 to 6 and 12 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants traverse, in part, this rejection.

Claim 1 has been cancelled.

The Office Action stated that, regarding Claims 1, 6 and 12, the term “film-like” renders the claims indefinite because the claims includes elements not actually disclosed (those encompassed by “film-like”), thereby rendering the scope of the claims unascertainable. Claim 1 has been cancelled; and Claims 6 and 12 have been made dependent on independent Claim 13 and amended to eliminate the “film-like” recitation problem.

The Office Action stated: that, regarding Claim 2, the term “preferably” renders the claim indefinite because it is unclear whether the limitation following the term are part of the claimed invention, thereby rendering the scope of the claims unascertainable; and see MPEP 2173.05(c). The “preferably” clause has been removed from Claim 2 and placed in new dependent Claim 21.

The Office Action stated that claims that have not been specifically mentioned are rejected since they depend from claims rejected under 35 U.S.C. 112, second paragraph. Claims 2 to 6 and 12 have been made dependent upon Claim 13.

The Office Action stated that the following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless--

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 to 6 and 12 have been rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamazaki et al. (U.S. Patent No. 4,778,058). Applicants disagree with this rejection. However, since this application is a divisional application drawn to the divisional invention/embodiment shown in Figure 3, applicants have cancelled Claim 1 and made Claims 2 to 6 and 12 dependent upon Claim 13.

This rejection should be withdrawn.

Claims 1 to 6 and 12 have been rejected under 35 U.S.C. 102(b) as being clearly anticipated by European Patent Application No. 0596747 (Schlaeppli et al.). Applicants disagree with this rejection. However, since this application is a divisional application drawn to the divisional/embodiment shown in Figure 3, applicants have cancelled Claim 1 and made Claims 2 to 6 and 12 dependent upon Claim 13.

This rejection should be withdrawn.

Before treating the specifics of the obviousness double-patenting rejection below, applicants show one of the reasons why the obviousness double-patenting rejection is in error and should be withdrawn.

The obviousness double-patenting rejection is defective on its face and for failure to follow Patent Office policy and the requirements of the Supreme Court's Graham decision [i.e., 383 U.S.1, 148 USPQ 459 (1966)].

Section 2141 of the M.P.E.P., (Rev. 3), states:

"Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As

quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art;
- and
- (D) Evaluating evidence of secondary considerations.”

[Emphasis Supplied]

Nowhere has the Examiner factually determined in the record the level of ordinary skill in the art. Accordingly, the Examiner has not made a valid obviousness double-patenting rejection or a valid factual showing of prima facie obviousness.

Section 2141.03 of the M.P .E.P., (Rev. 3), states:

“The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.’ *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).”

Since the Examiner has not factually determined in the record the level of ordinary skill in the art, there cannot be a *prima facie* showing of obviousness or a sustainable obviousness double-patenting rejection. The burden of proof is on the Examiner. Section 2144.08, II, of the M.P .E.P., (Rev. 3), states:

“A proper obviousness analysis involves a three-step process.

First, Office personnel should establish a *prima facie* case of unpatentability considering the factors set out by the Supreme Court in *Graham v. John Deere*. See, e.g., *In re Bell*, 991 F .2d 781,783 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ('The PTO bears the burden of establishing a case of *prima facie* obviousness.'); *In re Rijckaert*, 9 F .3d 1531,1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *Graham v. John Deere Co.* 383 U.S. 1; 17-18 (1966), requires that to make out a case of obviousness. one must:

(A) determining the scope and contents of the prior art;

(B) ascertaining the differences between the prior art and the claims in issue;

(C) determine the level of skill in the pertinent art; and

(D) evaluating any evidence of secondary considerations. If a *prima facie* case is established, the burden shifts to applicant to come forward with rebuttal evidence or argument to overcome the *prima facie* case.”

[Emphasis Supplied]

The Office Action stated:

"The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the 'right to exclude' granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969)."

"A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321 (d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement."

Claims 13 and 14 have been rejected on the ground of nonstatutory obviousness-type double patenting as being patentable over Claims 1 and 2 of U.S. Patent No. 6,726,363 (Patent '363). Applicants traverse this rejection.

The Examiner has not factually determined the ordinary level of skill in the art so the Examiner cannot determine what is obvious to or anything else, concerning one ordinarily skilled in the art. The Examiner has no basis for asserting the Claims 13 and 14 herein are obvious over Claims 1 and 2 of Patent '363. There has no basis for knowing anything concerning one ordinary skilled in the art.

The Examiner has not made any analysis of the differences, etc., to support this rejection. The Examiner has not shown that the claimed subject matter of the application is not patentably distinct from the claims of Patent '363.

Section 804.1 of the M.P.E.P. states:

“1. Obviousness-Type”

“In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an ‘obviousness-type’ nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent,..., when the issuance of a second patent would provide unjustified extension of the

term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.* 251 F.3d 955, 58 USPQ2d 1434, 1436-36 (Bd. Pat. App. & Inter. 2000).

A double patenting rejection of obviousness-type is 'analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103' except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F. 2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)."

"Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquires set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquires are summarized as follows:

(A) Determine the scope and content of a patent claim relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.'

"The conclusion of obviousness-type double patenting is made in light of these factual determination."

"Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent."

"When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992)." [Emphasis Supplied]

The Examiner has not made any of the Graham factual inquiries in the record, hence this obviousness double-patenting rejection is incorrect, has no support and fails.

The Office Action stated that, although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1 and 2 of U.S. Patent No. 6,726,363 contain every element of Claims 13 and 14 of the present application and as such anticipate Claims 13 and 14 of the present application. Applicants traverse this statement as not making sense, among other reasons. If the claims of Patent '363 anticipate applicants' Claims 13 and 14 this would not be an obviousness double-patenting rejection. The two sets of claims are patently distinct, and the Examiner has not proven otherwise.

In the application underlying Patent '363 the same Examiner made a four-way restriction requirement. This application is a division of Patent '363 made based on that earlier restriction requirement so obviousness double-patenting rejection is incorrect on its face since the same Examiner in effect earlier ruled that Claims 13 and 14 (Group II) of this application were patently distinct over Claims 1 and 2 (Group I) of Patent '363.

This rejection should be withdrawn.

The amendment to Claim 2 finds support on page 3, lines 2 to 7. The amendment to Claim 3 finds support in Figures 5 to 8. The amendment to Claim 4 finds support on page 7, lines 22 to 24. The amendment to Claim 5 finds support on page 7, last line, to page 8, first line.

New Claim 15 (and amended Claims 2 to 6) comes within the elected invention, and finds support in original Claim 2 and on page 3, lines 2 to 7.

Reconsideration, reexamination and allowance of the claims are requested.

Respectfully submitted,

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